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PATENT
37026-88081

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Attorney Docket No.: 37026-88081

Tadashi NARIU, et al.

Group Art Unit: 2815

Serial No.: 10/618,374

Examiner: Eugene Lee

Filed: 07/11/2003

For: IMAGE SENSOR

RESPONSE TO RESTRICTION REQUIREMENT
AND REQUEST FOR RECONSIDERATION
ON THE BASIS THAT APPLICANT HAS ALREADY COMPLIED
WITH THE PRIOR RESTRICTION REQUIREMENT
AND
REQUEST FOR INTERVIEW

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is responsive to the restriction requirement in the Official Action of June 7, 2004, in the above-referenced application.

Applicants believe the restriction requirement should not be imposed, as by filing the present continuation application, and by preliminary amendment, Applicants have already amended the claims in accordance with the Examiner's restriction requirement in the parent application. Because Applicants have already complied with Examiner's previous restriction requirement, Applicants believe Examiner's present restriction requirement should be withdrawn that prosecution on the merits should proceed.

NARIU, et al.
S.N. 10/618,374
#732639v2

It is believed helpful to explain what has already taken place and, if necessary to further clarify, Applicants will further explain by interview with Examiner by personal or telephonic interview.

In the parent of the present application, that being Serial No. 09/908,181, a first Official Action dated September 19, 2002, was a restriction requirement, Examiner having divided the application into the following two Groups:

I. Claims 1-15, 19-46, and 59-61 (semiconductor device)

II. Claims 16-18 and 47-58 (method of making semiconductor device)

In responding, Applicants elected Group I, with traverse.

The Applicants received a further Office action dated on February 12, 2003, there being now imposed this first restriction requirement (Applicants' traversal having been deemed non-persuasive), leaving pending claims 1-9, 11-15, and 19-22 under consideration.

In response to that Office action, Applicants filed a continuation application on July 11, 2003, which application was exactly the same application as originally filed as the parent application (which means there were claims 1-61 pending).

The continuation application is the present application Serial No. 10/618,374.

In the present application Applicants submitted a Preliminary Amendment, which cancelled all claims in Group II as according to the previous restriction requirement in the parent application, leaving only claims which belonged to Group I (claims 1-9, 12-15, and 21).

Even though Examiner now had in the application to examine claims 1-9, 12-15, and 21, Examiner issued the present restriction requirement by Office action dated June 7, 2004, on the premise that claims 1-61 were currently pending, and divided the application into the following two Groups:

I. Claims 1-9, 11-15, 19-46, and 59-61 (semiconductor device)

II. Claims 10, 16-18, and 47-58 (method of making semiconductor device)

Unfortunately the current restriction requirement appears to Applicants to be erroneous because:

a) The currently pending claims are only 1-9, 12-15, and 21; and they are the same claims which were Group I as according to Examiner's original restriction requirement.

b) Examiner has grouped the claims differently as between the first restriction requirement and the second restriction requirement; and

c) Since there was already a first restriction requirement dated September 19, 2002, and Applicants complied with it, Applicants believe something other than another Restriction Requirement should have been given out, such as an Office action on the merits of the claims.

As it accordingly altogether clear that Applicants have already amended the claims in accordance with the Examiner's opinion in the previous restriction requirement, it requested the present restriction requirement should be cancelled and that prosecution on the merits should proceed.

After submission of this response, the undersigned will telephone to examiner to clarify any uncertainty to set up an interview whether in person or will conduct a telephone interview on the points here raised. So also, examiner is free to telephone the undersigned.

Examination on the merits and allowance of the elected claims is solicited accordingly. Such action is respectfully requested.

Upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicants will indicate which are readable upon the elected species.

MPEP §809.02(a).

Respectfully submitted,

Date:

7 October 2004



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